

REMARKS

I. Summary of the Office Action

Claims 1, 2, 6-18, 35, 36, and 38-48 are pending in this application.

Claims 1, 2, 6-18, 35, 36, and 40-48 are rejected under 35 U.S.C. § 103(a) as being obvious from O'Connor et al. U.S. Patent Application No. 2005/0244138 (hereinafter "O'Connor") in view of Zigmond et al. U.S. Patent No. 6,698,020 (hereinafter "Zigmond").

II. Summary of Applicants' Reply

Independent claims 1 and 35 have been amended to more particularly define the claimed invention. Support for amended claims 1 and 35 can be found at, for example, page 1, line 25 through page 2, line 7 of applicants' provisional application specification.* Claims 36 and 40-44 have been amended to maintain proper antecedent basis to independent claim 35.

A telephonic interview was held on May 23, 2006.

The Examiner's rejections are respectfully traversed.

* The recitation of support for independent claims 1 and 35 is not intended to be exclusive. There may be support found elsewhere in the specification, including the non-provisional application.

III. Summary of the Telephonic Interview

The Examiner, the undersigned, and Hong Lin held a telephonic interview on May 23, 2006. Applicants and applicants' representatives wish to thank the Examiner for the courtesies extended during the interview. No agreement was reached during the interview.

IV. Applicants' Reply to the § 102 Rejection

Claims 1, 2, 6-18, 35, 36, and 40-48 are rejected under 35 U.S.C. § 103(a) as being obvious from O'Connor in view of Zigmond. This rejection is respectfully traversed.

Applicants' independent claims 1 and 35 refer to a method and system for providing a customized playback experience of recorded programming, customized in that one or more promotions are insertably recorded with respect to the recorded programming such that during playback, the recorded promotion(s) appear as if they were originally part of the recorded programming. As will be explained below, applicants' invention differs from the prior art in several respects. However, in order to appreciate the subtlety of the differences, further details of the invention are now discussed.

Claims 1 and 35 specify recording a selected program and recording a selected promotion to provide an integrated recorded program/promotion playback asset. Recording both the program and promotion provides the advantage of being able to insert the promotion at any point (e.g., beginning, end, or any point between the beginning and end of the program) with respect to the program, including programs which are commercial free. It is understood that even if the programming includes commercials, the recording of such commercials fails to read on applicants' claimed recording a promotion, wherein the promotion is independent of the programming.

Nowhere in O'Connor does it show or suggest recording a program and recording a promotion in a predetermined sequence to provide an integrated recorded program/promotion playback asset, wherein the promotion is independent of the program. At best, O'Connor teaches recording a video stream including a program and commercials, where those commercials are altered after the video stream has been recorded. Altering commercials after they have been recorded is completely contrary to applicants' claimed approach of recording promotions in a predetermined sequence to provide an integrated recorded program/promotion playback asset. Hence, in O'Connor, the only way a commercial, whether altered or not, can be played back after recording a

video stream is if the video stream included a commercial when it was recorded. Such an approach is completely contrary to applicants' claimed approach of recording promotions - promotions that are not included in the recorded programming - in a predetermined sequence to provide an integrated recorded program/promotion playback asset.

To make up for the deficiency of O'Connor, the Examiner relies on Zigmond. Zigmond refers to a system that provides insertion of advertisements into a video programming stream at the household level. Nowhere in Zigmond does it show or suggest recording a program and recording a promotion in a predetermined sequence to provide an integrated recorded program/promotion playback asset, wherein the promotion is independent of the program.

Applicants respectfully submit that one skilled in the art would not modify O'Connor to incorporate the advertisement insertion techniques of Zigmond because O'Connor teaches altering commercials included in a video stream after the video stream has been recorded, whereas Zigmond merely teaches inserting advertisements on-the-fly in the video stream as it is broadcast or being replayed from recorded media. Thus, even if O'Connor could be modified to include the teachings of Zigmond, which it could not, the combination would still fail to show or suggest each limitation of applicants' independent claims 1 and 35. As

discussed above, O'Connor is limited to altering commercials recorded as part of a video stream. During playback of the recording, Zigmond's ad insertion technique may be employed to insert advertisements during playback of the recording. Such insertion, however, fails to produce applicants' claimed "integrated recorded program/promotion playback asset."

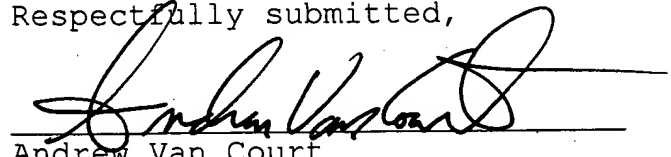
Furthermore, applicants respectfully submit that the Examiner's motivation is insufficient as a matter of law.

Accordingly, for at least the foregoing reasons, amended independent claims 1 and 35 and dependent claims 2, 6-18, 36, and 40-48, which depend from either amended independent claim 1 or 35, are not obvious from O'Conner in view of Zigmond. This rejection should therefore be withdrawn.

V. Conclusion

In view of the foregoing, claims 1, 2, 6-18, 35, 36, and 40-48 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



Andrew Van Court
Registration No. 48,506
Agent for Applicants
Fish & Neave IP Group
ROPES & GRAY LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000
Fax: (212) 596-9090